

REMARKS

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 1-12 are pending; Claims 1-12 are amended. No claims are newly added or canceled herewith. It is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, the Title of the Invention was objected to; Claim 1 was rejected under 35 U.S.C. § 102(e) as anticipated by Udagawa (U.S. Pat. No. 6,195,125); and Claims 1-12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Udagawa in view of Goto et al. (U.S. Pat. No. 5,678,106, hereafter Goto).

Applicants thank Examiner Aggarwal and Primary Examiner Le for the interview granted Applicants' representative on December 23, 2003. During the interview, the outstanding rejections of the pending claims were discussed with regard to Udagawa and Goto.

As discussed during the interview, the independent claims, as amended, include a feature that the piezoelectric element is charged during normal operation by a power supply used to power a strobo unit.

Support for this amendment may be found, for example, in the specification at page 17, lines 1-16 (describing normal operation of the piezoelectric element during use of the camera). Accordingly, it is respectfully submitted that no new matter is added by this amendment.

Additionally, the specification and claims have been amended to correct a minor informality in translation. Specifically, "stroboscope" has been amended throughout to be "strobo unit."

In the past, large circuit scale has been required because the output changeover function is needed in a boosting circuit. More specifically, a boosting circuit has been required to provide power to a piezoelectric element for displacing the image device.¹ In light of these difficulties, the Applicants developed the present invention to provide a digital camera capable of operating a piezoelectric element for displacing an imaging device, without requiring any particular boosting circuit in the digital camera and to provide a digital camera capable of obtaining an image having high definition.²

With regard to the rejection of Claim 1 under 35 U.S.C. § 102(e) as anticipated by Udagawa, the Office Action asserts at page 2 that the claimed configuration is inherent from the teachings of Udagawa.

However, as set forth in MPEP § 2112, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (emphasis in original). Moreover:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

As no technical reasoning was set forth to support the assertion of inherency (and the Office Action admits at page 3 that Udagawa does not disclose the claimed features), Applicants respectfully submit that the Office Action has not satisfied the burden of proof required for inherency. It is therefore respectfully requested that this rejection be withdrawn.

With regard to the rejection of Claims 1-12 under 35 U.S.C. § 103(a) as unpatentable over Udagawa in view of Goto, that rejection is also traversed.

¹ Specification, page 3, lines 3-12.

² Id. at lines 15-20.

As admitted in the outstanding Office Action at page 3, Udagawa fails to disclose or suggest an energy accumulating unit for supplying an electric power to another unit that is used as an electric power supply source for the piezoelectric element. The outstanding Office Action attempts to remedy this admitted deficiency by relying upon Goto.

As discussed during the interview, Goto describes that the power supply circuit P2 releases an output voltage of about 100 volts for driving the piezoelectric actuators in the normal state and also for driving a display illumination lamp 43. Goto also describes that the power supply circuit P3 releases an output voltage of about 200V for driving the piezoelectric actuators in an *abnormal state*, and also for driving a strobe discharge tube 44.³ Unlike Claims 1-12, however, Goto does not disclose or suggest that the piezoelectric element is charged by the power source for strobo unit emission during normal operation.

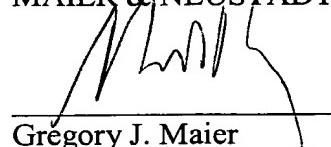
With regard to the objection to the Title, the Title has been amended herewith as suggested by the Examiner. It is therefore respectfully requested that this objection be withdrawn.

³ Goto, col. 13, lines 14-16.

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Grégory J. Maier
Registration No. 25,599
Robert T. Pous
Registration No. 29,099
Attorneys of Record

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
GJM:RTP:KDP\la

I:\ATTY\KDP\19'S\197811US\197811US AM 12-22-03(2).DOC